

## **REMARKS**

Applicants respectfully request reconsideration of the present Application. Claims 5-7, 9, 15, 16 and 25-29 are amended herein. Care has been exercised to introduce no new matter. Claim 21 is allowed. Claims 2, 5-7, 9, 10, 15, 16 and 25-29 are pending and are believed to be in condition for allowance.

### **Allowable Subject Matter**

Claim 21 is allowed.

### **Rejections based on 35 U.S.C. § 102**

#### **A) Applicable Authority**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”<sup>1</sup> “The identical invention must be shown in as complete detail as is contained in the . . . claim.”<sup>2</sup> The Federal Circuit recently clarified that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.”<sup>3</sup>

#### **B.) Rejections Based Upon Keely**

Claims 9-10 and 15-16 were rejected under 35 U.S.C. § 102(b) as ostensibly having been anticipated by Keely et al., U.S. Publication No. 2002/0049787.

---

<sup>1</sup> *Verdeggal Brothers v. Union Oil co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 2 USPQ 2d 1913, 1920 (Fed. Cir. 1989).  
See also, MPEP § 2131.

<sup>3</sup> *Net MoneyIN Inc. v. VeriSign Inc.*, Fed. Cir., 10/20/2008. See also MPEP §2031.

**Claims 9 and 15 are not anticipated by Keely at least because Keely does not disclose “receiving at least two display regions of one or more documents, wherein each display region includes an image of an annotation and related content encompassed by that display region within the one or more documents.”**

Claims 9 and 15 are amended herein to clarify that a display region includes an image of a portion of a document that is encompassed by the display region, and the image includes both the annotation and related content. This is in contrast to Keely. Keely either saves an annotation directly into a document where the annotation was made, or saves the annotation along with information that anchors, or links, the annotation to a specific location in the document. “In regards to modifiable documents, the system modifies the document to include the ink or annotation or at least adds a link at the location of the anchored object to the ink or annotation. In the case of non-modifiable documents, the system links the electronic ink to a file position in the non-modifiable document.”<sup>4</sup> Applicants have been unable to find any portion of Keely that discloses “receiving at least two display regions of one or more documents, wherein each display region includes an image of an annotation and related content encompassed by that display region within the one or more documents” as recited in claims 9 and 15, as amended.

For at least the reasons given above, Keely fails to disclose every feature of claims 9 and 15. Therefore, claims 9 and 15 are believed to be in condition for allowance.

**Claims 10 and 16 are allowable at least for their dependence on allowable claims.**

Claims 10 and 16 depend directly from claims 9 and 15, thus including all of the features of claims 9 and 15. For at least the reasons given above, Keely fails to disclose every

---

<sup>4</sup> Keely, ¶ 0012; *see also* Abstract.

feature of claims 9 and 15. Therefore, claims 10 and 16 are believed to be in condition for allowance for at least the reasons given above with regard to claim s 9 and 15.

**C.) Rejections Based Upon Hardock**

Claims 2, 5-7 and 25-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hardock et al. (“A Marking Based Interface for Collaborative Writing”, published: November 5, 1993, publisher: ACM).

**Claims 27-29 are not anticipated by Hardock at least because Hardock does not disclose “receiving data regarding an annotation which is associated with an active content that is non-static and that is included in a document, wherein the document is displayed in a user interface during a current access session.”**

With regard to claims 27-29, the Office stated that Hardock teaches “[r]eceiving data regarding an annotation which is associated with an active content displayed in a user interface during a current access session, the active content changes between a previous access session and the current access session (page 260, right column: whereas, received marked up annotations are displayed in a left window and the annotations annotate a document, which is active.”<sup>5</sup>

However, “a document, which is active” does not correspond at all to “active content” as recited in claims 27-29. Claims 27-29 are amended herein for clarification. As amended, claims 27-29 recite “receiving data regarding an annotation which is associated with an active content *that is non-static* and that is included in a document.” The “active content” recited in claims 27-29 does not refer to content of an active window; rather, it refers to a *type* of content included in a document, where the content is dynamic, i.e. it changes. For example, a

---

<sup>5</sup> *Office Action of 12/10/09*, p. 5.

dynamic ad displayed on a website, such that the ad changes whenever the website is refreshed, would be considered active content, as opposed to static content that remains the same when the website is refreshed.

Thus, Hardock does not disclose “receiving data regarding an annotation which is associated with an active content that is non-static and that is included in a document” as recited in claims 27-29, as amended.

With further regard to claims 27-29, the Office stated that Hardock teaches “[s]toring the annotation together with a static image of the active content as displayed in the current access session (Figure 4: whereas, the annotation is stored and shown in a static image in a left window. The static image, is a static image of an active document).”

However, Applicants respectfully submit that Hardock does not disclose “storing the annotation together with a static image of the active content as displayed in the current access session” as recited in claims 27-29. Hardock displays two views of a document. “The left view shows the marked up document received from the collaborators, with each reviewer's annotations appearing in a different color. . . . The right view shows the current version of the document.”<sup>6</sup> However, Hardock clearly states that the annotations are not stored with a static image of the text. “The annotations of several collaborators can be overlaid in the annotation view. To differentiate among the various collaborators markings, each set is displayed in a different color. Note that this is possible because *the markings are separate from the text document*, so different characteristics can be added to each set of markings. This is analogous to writing on a transparency overlaid on top of a paper document and writing on the transparency.”<sup>7</sup>

---

<sup>6</sup> Hardock, p. 260, col. 2 (emphasis added).

<sup>7</sup> Hardock, p. 262, col. 2 (emphasis added).

Thus, Hardock does not disclose storing the annotation together with a static image of the active content as displayed in the current access session. Additionally, the text document disclosed by Hardock does not correspond to the “active content” recited in claims 27-29 for at least the reasons given above.

**Claims 2 and 5-7 are allowable at least for their dependence on allowable claims.**

Claims 2 and 5-7 depend directly from claim 29, thus including all of the features of claim 29. For at least the reasons given above, Hardock fails to disclose every feature of claim 29. Therefore, claims 2 and 5-7 are believed to be in condition for allowance for at least the reasons given above with regard to claim 29.

**Claims 25 and 26 are allowable at least for their dependence on allowable claims.**

Claim 25 was rejected in view of Hardock. However, claim 25, as amended, now depends directly from claim 9, which was rejected in view of Keely. Claim 26 depends from claim 25 and thus now depends indirectly from claim 9. Claims 25 and 26 thus include all of the features of claim 9. For at least the reasons given above with regard to claim 9, Keely fails to disclose every feature of claim 9. Applicants respectfully submit that Hardock fails to disclose every feature of claim 9, nor is it relied upon to do so. Therefore, claims 25 and 26 are believed to be in condition for allowance for at least the reasons given above with regard to claim 9.

### **CONCLUSION**

For at least the reasons stated above, claims 2, 5-7, 9, 10, 15, 16 and 25-29 are now believed to be in condition for allowance. Applicants respectfully request withdrawal of the

pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or [mmsmith@shb.com](mailto:mmsmith@shb.com) (such communication via email is herein expressly granted) – to resolve the same. The fee for a Request for Continued Examination is submitted herewith by way of electronic payment. It is believed that no additional fee is due. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112, referencing attorney docket number 305996.01/MFCP.153622.

Respectfully submitted,

/Mollie M. Smith/

Mollie M. Smith  
Reg. No. 65,739

TLW/bp  
SHOOK, HARDY & BACON L.L.P.  
2555 Grand Blvd.  
Kansas City, MO 64108-2613  
816-474-6550